

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORDON L. BENOIT and RUDOLPH F. VANDERVELDEN

Appeal No. 1998-0275
Application 08/467,484

ON BRIEF

Before KIMLIN, GARRIS and WALTZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 19-27. Claim 46, the other claim remaining in the present application, has been withdrawn from consideration. Claim 19 is illustrative:

19. A method for preparing an embossed, curl-resistant laminated multilayer film substrate for use in the production of banknotes, security papers and the like which comprises:

i) laminating (a) a first layer having inner and outer sides, comprising at least about 50 weight percent of a high density polyethylene having

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a density of at least about 0.94, said first layer being oriented in the transverse direction (TD) to a degree which is at least three times greater than the degree of orientation present in the machine direction (MD) to

(b) a second layer comprising inner and outer sides, comprising at least about 50 weight percent of a high density polyethylene having a density of at least about 0.94, said second layer being oriented in the transverse direction to a degree which is at least three times greater than the degree of orientation present in the machine direction, with a laminating adhesive resin which comprises a component selected from the group consisting of low density polyethylene (LDPE) and linear low density polyethylene (LLDPE), said second layer being laminated in the film substrate so that said transverse direction of orientation of said second layer is substantially aligned with said transverse direction of orientation of said first layer, thereby forming an embossable substrate; and

ii) embossing said substrate.

The examiner relies upon the following references as evidence of obviousness:

1943	Kallmann	2,330,718	Sep. 28,
1969	Aulik et al. (Aulik)	3,484,336	Dec. 16,
1980	Lee	4,186,943	Feb. 05,
1981	Lee et al.	4,247,318	Jan. 27,
20, 1985	Solomon et al. (Solomon)	4,536,016	Aug.

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Appellants' claimed invention is directed to a method for making an embossed, laminated multilayer film that finds utility in producing banknotes, security papers, etc. The method entails laminating first and second layers comprising high density polyethylene that are oriented in the transverse direction "to a degree which is at least three times greater than the degree of orientation present in the machine direction." In addition, the

first and second layers are laminated "so that said transverse direction of orientation of said second layer is substantially aligned with said transverse direction of orientation of said first layer."

Appealed claims 19 and 22-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kallmann in view of Lee et al. and Solomon. Claims 20 and 21 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over the stated combination of references in combination with the admitted prior art. Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kallmann in view of Lee et al., Solomon and Lee, while

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claims 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kallmann in view of Lee et al., Solomon and Aulik.

Upon careful consideration of the opposing arguments presented on appeal, we concur with appellants that the examiner has not established a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

Although we do not subscribe to appellants' position that Solomon is based on the use of oriented polypropylene¹, appellants have advanced arguments pertaining to specific claim limitations recited in independent claim 19 which have not been addressed by the examiner. To wit, appellants submit that there is no prior art disclosure of orienting the first and second layers in the transverse direction to a degree which is at least three times greater than the degree of orientation present in the machine direction (paragraph bridging pages 3 and 4 of brief), and "there is no disclosure laminating a first layer to second layer so that the

¹We find no reference to polypropylene in the disclosure of Solomon, which seems directed to bi-axially-oriented polymeric films in general.

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transverse direction of orientation of the second layer is substantially aligned with the transverse direction of orientation of the first layer" (page 4 of brief, first full paragraph). On the other hand, we have searched the examiner's answer in vain for any rationale which explains why these argued claimed features would have been obvious to one of ordinary skill in the art within the meaning of § 103. In addition, appellants contend at page 6 of the brief that "[t]here is no disclosure of polyethylenimide, as required by claim 27", whereas the examiner's answer is silent to this challenge. Consequently, the examiner has failed to establish a prima facie case of obviousness of claimed features for which appellants have advanced specific arguments. Manifestly, this constitutes reversible error.

Based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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